



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,814	03/23/2001	Thomas Lange	449122002200	1022

25227 7590 08/12/2004

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

PHAM, BRENDA H

ART UNIT PAPER NUMBER

2664

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,814

Applicant(s)

LANGE ET AL.

Examiner

Brenda Pham

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5 is/are rejected.
- 7) ☐ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5 have been examined.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

The recitation, "in which the signaling and useful information belonging to the call connection" recited in claim 1, line 6. Should it be --in which useful information belonging to the call connection--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by **Dunn et al** (US 6,324,280), hereinafter referred to as **Dunn**.

Claim 1, **Dunn** discloses a method for exchanging signaling information for at least one call connection, which can be switched via a packet-switched network, between subscribers of a circuit-switched network, comprising **(referring to figure 1)**:

Art Unit: 2664

a digital originating exchange (1) and a digital destination exchange (2) which are coupled via a digital transit exchange to an access node (3) which forms an access to the packet-switched network (10) for the circuit-switched network (21), in which useful information belonging to the call connection can be transmitted via the packet-switched network (10) between such access node in the form of data packets, **{The toll access switch 1 contains a Protocol handler/vocoder 3 for interfacing between Internet voice packets, and the pulse code modulation, (PCM), bit stream received from the local PSTN 21 (column 2, lines39-42)},**

wherein the signaling information is exchanged between the originating (1) and destination exchanges (2), instead of via the packet-switched network (10), via a signaling network (5) coupled to the circuit-switched network (11) **{a series of packets are exchanged between the originating toll access switch 1, and the terminating toll access switch 2. Initial address message, (IAM 40) is sent from the originating toll access switch 1 to the terminating toll access switch 2 over the CCS7 network 5 (column 3, line 35-48)}.**

Claim 2, **Dunn** teaches the method according to claim 1, wherein the useful information to be transmitted via the packet-switched network, and its associated signaling information to be conducted via the signaling network, are provided with a common, unambiguous identification number (see figure 1).

Claim 5, **Dunn** further teaches the method according to claim 1, wherein the digital destination exchange is coupled to a device functioning as an access node instead of the access node **{(The toll switch 1 contains a Protocol handler/vocoder 3 for interfacing between Internet voice packets, and the pulse code modulation, (PCM), bit stream received from the local PSTN 21 (column 2, lines 39-42))}**.

Allowable Subject Matter

5. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record does not teach or fairly suggests in combination wherein the billing method of the circuit-switched network is applied to the call connection established via the packet-switched network by means of the signaling information conducted via the signaling network.

The prior art further fails to teach wherein a direct connection exists between the access node belonging to the originating exchange and another access node belonging to the destination exchange or between the originating exchange and the destination exchange, in which the functions of the access node are integrated, a traffic control function present in the originating or transit exchange is applied to the traffic control function of the useful information, belonging to the call connection, in the form of data packets and the signaling information to be transmitted via the signaling network.

Art Unit: 2664

Conclusion

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Fax to:

(703) 308-6743, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington VA Sixth Floor (Receptionist)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (703) 308-0148. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

August 4, 2004
Brenda Pham



WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600